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LAZARO, DAVID R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TONI MARKUS PIPONIUS, LAURI TAPIO AARNIO, TIMO
PETTERI KIRAVUO, EIJA RIITTA HELENA LEHTOVAARA, TERO
ILARI SILVENNOINEN, and HANNU H. KARI

Appeal 2009-006258
Application 09/956,989
Technology Center 2400

Before: JOSEPH L. DIXON, ST. JOHN COURTENAY, and
THU A. DANG, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1-11, 13-22, 24, 25, and 27-31. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to proxy for content service. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for providing a piece of content to a subscriber terminal from a content server, wherein the provision of the content from the content server to the subscriber terminal is controlled by a proxy, and said control of the content provision comprises the following steps:

- receiving, from the subscriber terminal, in the proxy a content request for providing the content,
- determining, by the proxy, whether or not the content is chargeable content, wherein the determining step includes accessing a database that includes information that is indicative of which content is chargeable and which content is free to end users connected to a network,
- determining by means of the proxy a billing address for the chargeable content,
- providing the content corresponding to the content request under the control of the proxy from the content server to the subscriber terminal, and
- generating billing information related to the chargeable content, wherein generating billing information includes accessing a subscriber terminal profile, and wherein the subscriber terminal profile includes a prepaid amount provided by an end user of the subscriber terminal.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Schutte	US 5,319,454	Jun. 7, 1994
Kimura	US 5,778,189	Jul. 7, 1998
Reeder	US 5,852,812	Dec. 22, 1998
Ronen	US 5,905,736	May 18, 1999
Melen	US 5,956,391	Sep. 21, 1999
Roden	US 5,970,477	Oct. 19, 1999
Ginzboorg	US 6,047,051	Apr. 4, 2000
Davis	US 6,389,537 B1	May 14, 2002
Cockrill	US 2002/0059114 A1	May 16, 2002

REJECTIONS

Claims 1, 6-8, 11, 13, 16, 19-22, 27, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginzboorg and Davis. Ans. 4.

Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginzboorg, Davis, and Ronen. Ans. 8.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginzboorg, Davis, and Melen. Ans. 10.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginzboorg, Davis, and Roden. Ans. 11.

Claims 10, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginzboorg, Davis, and Cockrill. Ans. 12.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginzboorg, Davis, and Reeder. Ans. 14.

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginzboorg, Davis, and Kimura. Ans. 15.

Claims 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginzboorg, Davis, and Schutte. Ans. 16.

Claims 29-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginzboorg and Ronen. Ans. 17.

ISSUES

Has the Examiner set forth a sufficient showing of obviousness of independent claim 1? Specifically, do the teachings of Ginzboorg teach the claimed:

receiving, from the subscriber terminal, in the proxy a content request for providing the content, - determining, by the proxy, whether or not the content is chargeable content, wherein the determining step includes accessing a database that includes information that is indicative of which content is chargeable and which content is free to end users connected to a network, - determining by means of the proxy a billing address for the chargeable content, - providing the content corresponding to the content request under the control of the proxy from the content server to the subscriber terminal?

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416.

Consistent with *KSR*, the Federal Circuit recently recognized that “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some

combinations would have been obvious where others would not.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that *Leapfrog* had presented no evidence that the proposed modification was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* at 1162.

The question of obviousness is “based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently” *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001) (citations omitted). Thus, “[t]he inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.” *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995) (affirmed 35 U.S.C. § 103 rejection based in part on inherent disclosure in one of the references).

In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ANALYSIS

At the outset, we note that Appellants have not set forth separate arguments for patentability of independent claim 29 and the dependent claims. (App. Br. 12). Therefore, we will group independent claim 29 and the dependent claims as standing or falling with independent claim 1.

Appellants argue that claim 1 recites an architecture in which the provision for the content from the content server to the subscriber terminal is “controlled by a proxy.” The proxy controls the information flow from the

Content Server to the subscriber terminal. Nothing in *Ginzboorg* accounts for this control... *Ginzboorg* , instead, offers a billing server that *authenticates or authorizes content: not control its delivery*." (App. Br. 10). We find Appellants' argument to be unpersuasive of error in the Examiner's showing of obviousness wherein authorizing content is deemed to be a form of control of the delivery since unauthorized content would not be delivered.

Appellants set forth three arguments concerning the timing of the billing at page 11 of the Appeal Brief, but we find no express support in the language of independent claim 1 for these arguments. Therefore, Appellants' arguments do not show error in the Examiner's showing of obviousness of independent claim 1.

Appellants argue that "[u]sing the architecture outlined by the pending claims, the content server would not have to be modified to provide this extra communication because the proxy is configured to make content routing decisions." (App. Br. 11). Appellants' argument is again not commensurate in scope with the broader language of independent claim 1 and therefore does not show error in the Examiner's showing of obviousness thereof.

Appellants further contend that *Ginzboorg* fails to discern between chargeable and free content and that the proxy is tasked with the determination not some other random element in the system. (App. Br. 11). The Examiner has identified, at page 23 of the Answer, "the proxy" as the billing server. The Examiner further maintains that columns 10 and 13 of *Ginzboorg* clearly establish that there at least some services that are free and some that are chargeable and that "one of ordinary skill in the art would understand that there is some form of inherent mechanism for discerning between the two types." (Ans. 23). The Examiner further proffers the

teachings of column 6 of Ginzboorg which describes the billing server running a process to determine how to charge the customer based on the requested content. We agree with the Examiner that there would be some inherent determination to charge. Alternatively, we conclude that it would have been obvious to one of ordinary skill in the art to have the billing server determine whether or not content was chargeable or free based upon the teachings of Ginzboorg. While Appellants identify that column 13 of Ginzboorg does not require free services to be stored in the billing server database (Reply Br. 3), Ginzboorg clearly suggests that one alternative would be to require free services to be stored in the billing server database and the alternative would be to not store free services in the billing server database. Therefore, we do not find Appellants' argument to be persuasive of error in the Examiner's showing of obviousness of independent claim 1.

Furthermore, we find that column 13, line 30—column 14, line 8, of Ginzboorg discusses billing servers in geographically limited areas and how they may operate locally and also interact. We find this teaching to further suggest that the billing server can do all functions locally and further can interact with other billing servers to provide additional content.

Appellants next set forth the significance of the ability of the proxy to make the determination between chargeable and free content, but Appellants' contentions are not supported by the express language of independent claim 1. (App. Br. 11-12). Therefore, these arguments are not persuasive of error in the Examiner' showing of obviousness.

Appellants further contend that a "fundamental difference" between Ginzboorg and the claims is that Ginzboorg pertains to "a service and not to content delivery." (App. Br. 12). Appellants further argue that Ginzboorg deals with the type of service (for example video-on-demand) and not

specific content. Again, we find Appellants' argument is not commensurate in scope of the express language of independent claim 1 where "specific" content is not recited in the language of the claim. Furthermore, we find the distinction between chargeable content and free content meets the broad language of independent claim 1. Additionally, we find that the teachings of Davis reinforce the video-on-demand and pay-per-view uses which would charge for the specific/actual content viewed. Therefore, we find Appellants' argument unpersuasive of error in the Examiner's showing of obviousness of independent claim 1.

Appellants set forth a discussion of case law concerning the motivation to combine and the need for an articulated reason why the claimed invention is obvious (App. Br. 13-14), but Appellants do not address the Examiner's articulated reasons for the combination as set forth at page 5 of the Answer. Therefore, Appellants' argument does not show error in the Examiner's showing of obviousness of independent claim 1.

Since Appellants have not shown error in the in the Examiner's showing of obviousness, we will sustain the rejection of independent claim 1 and independent claims 29 and dependent claims 2 -11, 13-22, 24, 25, 27, 28, 30, and 31 which Appellants have not set forth separate arguments for patentability thereto.

CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 1-11, 13-22, 24, 25, and 27-31 as obvious.

DECISION

For the above reasons, the Examiner's rejection of claims 1-11, 13-22, 24, 25, and 27-31 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

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